

12-08-08

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Lencki et al.

Attorney Docket No.: CLC 00.02

Serial No.: 09/748,359

Filed: 12/26/2000

For: System and Method for
Facilitating Selection of
Benefits

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

SUPPLEMENT TO
PETITION FOR SUSPENSION OF THE RULES UNDER 37 C.F.R. §1.183

In response to the Decision on Petition mailed September 25, 2008, Applicant submits this communication as a supplement to the Petition For Suspension of the Rules Under 37 C.F.R. §1.183, filed on April 9, 2008.

Applicant hereby submits a declaration under 37 C.F.R. § 1.131¹ in connection with the above-referenced application in a form that is executed by David A. Gordon, on behalf of the assignee, Choicelinx Corporation.

¹ As discussed with the Senior Petitions Attorney, Ms. Nancy Johnson, the Exhibits to the Declaration have not been resubmitted herewith due to the length of the same. Also, the Declaration has been submitted under seal subject to the Petition to Expunge filed on April 9, 2008.

Applicant also wishes to update the Patent and Trademark Office as to recent communications with the inventors. On behalf of Choicelinx Corporation, on October 13, 2008, the undersigned again sent a copy of the declaration under 37 C.F.R. § 1.131 (previously sent to the inventors on April 8, 2008) to the last known addresses of the inventors, or their counsel, as applicable, requesting that they execute the same. None of the inventors executed the declaration. See attached Statement of Facts in Support of Supplement to Petition Under 37 C.F.R. § 1.183 ("Statement"), paragraphs 4 - 8, which Statement is incorporated herein by reference.

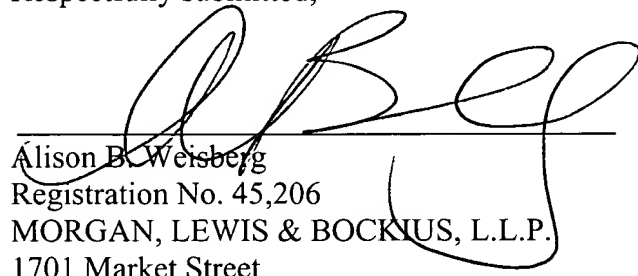
Thus, Applicant renews its request for a suspension of the rules in this case so that the declaration under 37 C.F.R. §1.131 may be accepted by the Patent Office without the signature of all of the inventors. See M.P.E.P § 715.04(I).

Please contact the undersigned attorney with any questions or comments regarding this submission. Please charge any fees required in connection with this submission to Deposit Account No. 50-0310.

Respectfully submitted,

Dec 5, 2008
(Date)

By:


Alison B. Weisberg
Registration No. 45,206
MORGAN, LEWIS & BOCKIUS, L.L.P.
1701 Market Street
Philadelphia, PA 19103-2921
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Lencki et al.

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Attorney Docket No.: CLC 00.02

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Statement of Facts in Support of Supplement to Petition Under 37 C.F.R. § 1.183

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

I, Alison B. Weisberg, hereby declare:

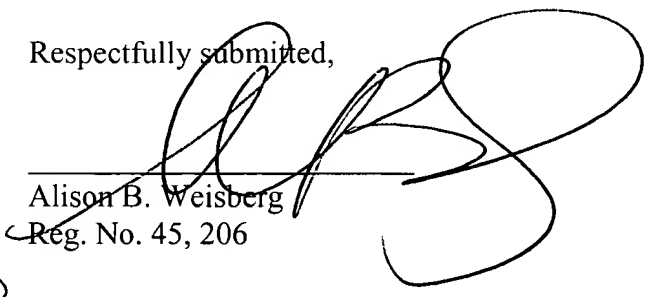
1. I am making this statement of facts in support of a Supplement to Petition Under 37 C.F.R. § 1.183 Requesting Waiver of the Signature of an Inventor on a Declaration Under 37 C.F.R. § 1.131.
2. I am the attorney of record for Choicelinx Corporation, the assignee of the above-referenced application by way of the assignment recorded at Reel 0113961/Frame 0536.
3. In connection with the prosecution of this application, Choicelinx seeks to submit a Declaration Under 37 C.F.R. § 1.131.
4. On October 13, 2008, I again forwarded to inventor, Patrick Miller, and the attorneys representing inventors Christopher Henchey and Donna Lencki (namely, Andru Volinsky, Esquire and Richard Molan, Esquire, respectively) the declaration (previously forwarded to them on April 8, 2009) for their review and signature. A copy of my letter is attached hereto as Exhibit 1. The letter was sent to the last known addresses of Patrick Miller, Andru Volinsky and Richard Molan, as set forth in my letter.
5. My October 13th letter asked that each of the inventors provide any comments or changes they may have to the declaration to Don Perreault and, if the declaration met with their approval, to execute the same and return it to me by October 20, 2008.
6. Mr. Molan, representing inventor Henchey, wrote to me on October 22, 2008. A copy of Mr. Molan's letter is attached hereto as Exhibit 2.

7. On November 25, 2008, I responded to Mr. Molan's October 22nd letter, again asking that Mr. Henchey's execute the declaration and return to me by December 4, 2008. A copy of my November 25th letter is attached hereto as Exhibit 3.

8. As of the time of my signing of this declaration, none of the inventors has returned to me an executed copy of the declaration.

I declare that all statements made herein of my own knowledge are true and that all statements made on information from review of the file history of the patent application are believed to be true, and further that these statements were made with the knowledge that willful false statements or the like so made are punishable by fine or imprisonment or both under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the patent application or any patent issued thereon.

Respectfully submitted,



Alison B. Weisberg
Reg. No. 45, 206

Date:

Dec. 5, 2008

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Alison B. Weisberg
Of Counsel
215.963.5091
aweisberg@morganlewis.com

October 13, 2008

VIA OVERNIGHT DELIVERY

Patrick B. Miller
171 Beech Hill Road
Campton, NJ 03223-4304

Andru Volinsky, Esquire
Bernstein Shur
Jefferson Mill Building
670 North Commercial Street, Suite 108
PO Box 1120
Manchester, NH 03105-1120

Richard Molan, Esquire
Cook & Molan, P.A.
100 Hall Street
PO Box 1465
Concord, NH 03302

Re: U.S. Patent Application No. 09/748,359 entitled "System and Method for Facilitating Selection of Benefits"

Dear Messrs. Miller, Volinsky, and Molan:

Following up on Choicelinx's communications with you back in April of this year, I am writing to you, Mr. Miller, as a named inventor on the above-referenced patent application, and Messrs. Volinsky and Molan, as representatives of the other named inventors on the patent application, Donna Lencki and Christopher Henchey.

In connection with the prosecution of this application, Choicelinx filed with the Patent and Trademark Office the enclosed, unsigned Declaration Under 37 U.S.C. 1.131 on April 9, 2008. In the event Choicelinx has the opportunity to re-submit the Declaration to the Patent and Trademark Office in a form that is signed by the inventors, we ask that each of Messrs. Miller

October 13, 2008

Page 2 -

and Henchey, and Ms. Lencki, kindly review the Declaration and contact Don Perreault (603-668-6560) if there are any questions regarding or changes to the same. If the declaration meets with your approval, Mr. Miller, and that of Mr. Henchey and Ms. Lencki, kindly have the same executed and fax the last page of the Declaration to me at 215-963-5001. If you are willing to assist as we have requested, we ask that this be accomplished by Monday, October 20, 2008.

Very truly yours,


Alison B. Weisberg

Enclosures

cc: Mr. David A. Gordon (w/o enclosures)
Donald J. Perreault, Esquire (via overnight delivery w/ enclosures)



Richard E. Molan
Admitted in NH

Glenn R. Milner
Admitted in NH & MA

John S. Krupski
Admitted in NH

October 22, 2008

Alison B. Weisberg, Esq.
Morgan, Lewis & Bockius LLP
1701 Market St.
Philadelphia, PA 19103-2921

RE: U.S. Patent Application No. 09/748,359 entitled "System and Method for Facilitating Selection of Benefits"

Dear Attorney Weisberg:

I write you in regard to your recent delivery of a letter dated October 13, 2008 with numerous appended documents including a Declaration which you have asked my client, Christopher Hency, to sign. Unfortunately, we were not able to comply with your request by the date you sought as the time from receipt to the time of requested signature was less than a week.

Mr. Hency, who is the Chief Operating Officer of a healthcare company, was not able to review these documents until the weekend and a number of issues arise that cause him to decline to sign the Declaration at this point.

As you may be aware, Mr. Hency has had no discussions with those applying for the patent in several years. Frankly, we do not understand what the status or the context of this request for this Declaration is. A clarification of the status and context of the application may make it easier to put this matter to rest.

However, according to my client, the claims made are not the original claims that he was familiar with and he has had no opportunity to review these matters in depth. He questions why they have been modified and certainly is not able to execute his signature under Declaration #78 under the penalty of law. He is aware of documents that may or may not have been included in this voluminous package and has not been provided the opportunity to review all of the documents involved in this application.

100 Hall Street, Suite 101
Concord, NH 03301

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Alison B. Weisberg, Esq.
Morgan, Lewis & Bockius LLP
October 22, 2008
Page 2

He does not act in any way with a notion to impede the granting of the patent, however, the short notice and the inability to review documents makes it impossible for him to cooperate by signing the declaration at this time. I do want to note that back in April Mr. Henchey offered to review the document files to assist and aid in the prosecution of an application but to date no one has taken him up on that proffer.

If you wish to pursue this further, please do not hesitate to contact me

Sincerely,

Dictated but not read or signed

Richard E. Molan

REM/tec

Cc: Christopher Henchey

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Alison B. Weisberg
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aweisberg@morganlewis.com

November 26, 2008

VIA FACSIMILE

Richard Molan, Esquire
Cook & Molan, P.A.
100 Hall Street
PO Box 1465
Concord, NH 03302

Re: U.S. Patent Application No. 09/748,359 entitled "System and Method for Facilitating Selection of Benefits"

Dear Mr. Molan:

I am in receipt of your letter of October 22, 2008, wherein you raise questions regarding Choicelinx's request for Mr. Henchey's cooperation in verifying and executing a declaration under 35 CFR 1.131 (the "Declaration"), forwarded to you for review, and wherein you assert several reasons why Mr. Henchey purportedly is not able to comply with Choicelinx's request. I address each of your points in turn.

You first state that Mr. Henchey was unable to comply with Choicelinx's request because he did not have sufficient time to consider the Declaration. The Declaration was originally forwarded to you and Mr. Henchey on April 8, 2008. We believe Mr. Henchey has had sufficient time to review the Declaration.

You next state that you do not understand the status or context of Choicelinx's request for the Declaration. The context of Choicelinx's request was previously explained to you in my communications in March and April of this year, as well as in my letter of October 13, 2008. The Declaration must be signed, either by the inventors, or by Choicelinx if the inventors refuse.

You further state that the claims included in the Declaration were not the original claims with which Mr. Henchey was familiar, and that Mr. Henchey was not provided the opportunity to

November 26, 2008
Page 2

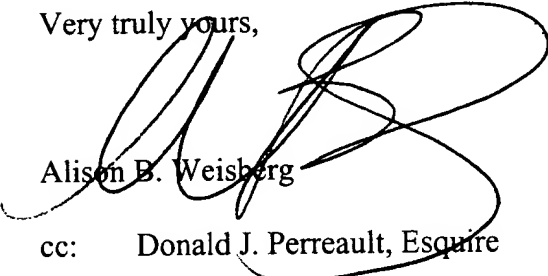
review all of the documents involved with the application. The claims in the Declaration are the independent claims as they currently stand before the Patent Office. The claims, and any other matter pertaining to the prosecution of the patent application, can be verified through the public record available via the U.S. Patent Office website at www.uspto.gov.

Finally, you state that Mr. Henchey offered back in April to review document files and assist and aid in the prosecution of the application, but that no one has taken him up on that offer. Choicelinx has not asked Mr. Henchey to review document files or aid in the prosecution of the application in any way other than to review the Declaration; let us know if he has any questions or comments regarding the Declaration; and, if he can verify the statements therein, execute it. If Mr. Henchey is willing to execute the Declaration, we ask that he do so by December 4, 2008.

If we do not hear from you by then, we will ask that the Patent Office accept the Declaration signed by Choicelinx on behalf of the inventors.

Please call me if you have any questions, or would like to discuss further.

Very truly yours,



Alison B. Weisberg

cc: Donald J. Perreault, Esquire

TRANSMISSION REPORT

(WED) NOV 26 2008 10:50

DOCUMENT #	TIME STORED	TIME SENT	DURATION	PAGE(S)	MODE	RESULT
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Morgan Lewis
C O U N S E L O R S A T L A W

SEND TO

Name: Richard Molan, Esq. Firm: Molan Milner
FAX #: 603-410-6031 Telephone #: 603-410-6011

FROM

Name: Alison B Weisberg Floor: 8th
Operator Sending: Telephone # 215.963.5091
FAX #: 877.432.9652 Date Sent: 11/26/2008 Number of Pages: (3)
(including cover page)

COMMENTS

FAX MESSAGE

THE INFORMATION CONTAINED IN THIS FAX MESSAGE IS INTENDED ONLY FOR THE PERSONAL AND CONFIDENTIAL USE OF THE NAMED RECIPIENT(S). THIS MESSAGE MAY BE AN ATTORNEY-CLIENT COMMUNICATION AND AS SUCH IS PRIVILEGED AND CONFIDENTIAL. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT OR AN AGENT RESPONSIBLE FOR DELIVERING IT TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT YOU HAVE RECEIVED THIS DOCUMENT IN ERROR AND THAT ANY REVIEW, DISSEMINATION, DISTRIBUTION, OR COPYING OF THIS MESSAGE IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE, AND RETURN THE ORIGINAL MESSAGE TO US BY MAIL. THANK YOU.

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DECEMBER 5, 2008

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: U.S. Patent Application Serial No. 09/748,359
Entitled "System and Method for Facilitating Selection of Benefits"
Attorney Docket No. CLC 00.02

Dear Sir:

Enclosed for filing in connection with the above-referenced application are the following:


- 1) Supplement to Petition for Suspension of the Rules Under 37 C.F.R. 1.183 (2 pages);
- 2) Statement of Facts In Support of Petition Under 37 C.F.R. 1.183 (2 pages), with Exhibits 1, 2 and 3 attached thereto comprising a letter dated October 13, 2008, a letter dated October 22, 2008, and a letter dated November 26, 2008; and
- 3) Declaration Under 37 C.F.R. 1.131, executed by assignee of record, Choicelinx Corporation (17 pages) (FILED UNDER SEAL – PROPRIETARY – SUBMITTED FOR CONSIDERATION UNDER M.P.E.P. s. 724, SUBJECT TO PETITION TO EXPUNGE FILED APRIL 9, 2008).

EXPRESS MAIL CERTIFICATE (37 C.F.R. § 1.10)

Express Mail Label No. E V 806818758US Date of Deposit Dec 5, 2008

I hereby certify that this paper, and the papers and/or fees referred to herein as transmitted, submitted or enclosed, are being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Name Alison B. Weisberg

Signature 

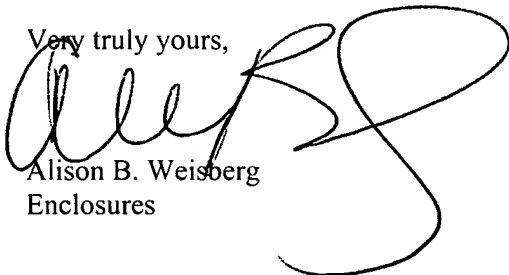
Commissioner for Patents
December 5, 2008
Page 2

Please note that, simultaneously with the filing of this submission, the Declaration Under 37 C.F.R. 1.131 that is the subject of this petition is being filed along with a Supplemental Amendment in response to the Office Action of October 9, 2007.

Kindly acknowledge receipt of these documents by returning the enclosed self-addressed stamped postcard to the undersigned.

The Commissioner is hereby authorized to charge any fees required in connection with this filing to Deposit Account No. 50-0310. A duplicate of this authorization is enclosed.

Very truly yours,

A large, stylized handwritten signature in black ink, appearing to read 'Alison B. Weisberg', is written over the typed name and extends upwards and to the right.

Alison B. Weisberg
Enclosures

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COPY

Morgan Lewis
COUNSELORS AT LAW

Alison B. Weisberg
Of Counsel
215-963-5091
aweisberg@morganlewis.com

December 5, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: U.S. Patent Application Serial No. 09/748,359
Entitled "System and Method for Facilitating Selection of Benefits"
Attorney Docket No. CLC 00.02

Dear Sir:

Enclosed for filing in connection with the above-referenced application are the following:

- 1) Supplemental Amendment and Response to Official Action (25 pages);
- 2) Declaration Under 37 U.S.C. 1.131 (17 pages), executed by Choicelinx Corporation and accompanying bound packet of Exhibits A through KK (**FILED UNDER SEAL – PROPRIETARY – SUBMITTED FOR CONSIDERATION UNDER M.P.E.P. § 724 AND SUBJECT TO PETITION TO EXPUNGE FILED APRIL 9, 2008**).

EXPRESS MAIL CERTIFICATE (37 C.F.R. § 1.10)

Express Mail Label No. EV 806818741/US

Date of Deposit

Dec 5, 2008

I hereby certify that this paper, and the papers and/or fees referred to herein as transmitted, submitted or enclosed, are being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Name Alison B. Weisberg

Signature

Commissioner for Patents
December 5, 2008
Page 2

Please note that, simultaneously with the filing of this submission, a Supplement to Petition For Suspension of the Rules Under 37 C.F.R. 1.183 has been filed, submitting a declaration under 37 C.F.R. 1.131 executed by Choicelinx Corporation.

Kindly acknowledge receipt of these documents by returning the enclosed self-addressed stamped postcard to the undersigned.

The Commissioner is hereby authorized to charge any fees required in connection with this filing to Deposit Account No. 50-0310. A duplicate of this authorization is enclosed.

Very truly yours,


Alison B. Weisberg
Enclosures